REMARKS

This is a full and timely response to the non-final Office Action (Paper No. 4) mailed by the U.S. Patent and Trademark Office on May 24, 2004. Claims 1-20 remain pending in the present application. Applicants have amended independent claims 1, 6, 11 and 16 to recite a "predetermined" text portion. Applicants respectfully submit that no new matter has been introduced and that no additional search need be performed. In view of the foregoing amendments and following remarks, reconsideration and allowance of the present application and claims are respectfully requested.

I. Response to 35 U.S.C. §102 Rejection – Claims 1-20

A. Statement of the Rejection

Claims 1-20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,507,643 to Groner (hereafter *Groner).*

B. Discussion of the Rejection

Applicants respectfully traverse the rejection of claims 1-20 under 35 U.S.C. §102(b) over *Groner* for at least the reason that *Groner* fails to disclose, teach, or suggest each element in the claims.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen,* 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.,* 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). The test is the same for a process. Anticipation requires identity of the claimed process and a process of the prior art. The claimed process, including each step thereof, must have

been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.,* 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.,* 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.,* 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Those elements must also be arranged as in the claim. *See, e.g., Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); *Carella v. Starlight Archery & Pro Line Co.,* 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.,* 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). Accordingly, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention.

For at least the reason that *Groner* fails to disclose, teach, or suggest at least Applicants' method for entering predetermined text into an electronic device, comprising entering a predetermined text portion into the electronic device, storing the predetermined text portion in a memory, recording a voice portion into the electronic device, storing the voice portion in the memory, associating the voice portion with the predetermined text portion, using voice recognition to recall the predetermined text portion that is associated with the voice portion, associating the predetermined text portion with information to be entered in the electronic device, and inserting the predetermined text portion into the information to be entered in the electronic device," as recited in claim 1, Applicants respectfully submit that *Groner does not* anticipate Applicants' independent claim 1.

Similarly, for at least the reason that *Groner* fails to disclose, teach, or suggest at least Applicants' system for entering predetermined text into an electronic device, comprising means for entering a predetermined text portion into the electronic device, a first memory means for storing the predetermined text portion, a recording means for recording a voice portion into the electronic device, a second memory means for storing the voice portion, means for associating the voice portion with the predetermined text portion, means for using voice recognition to recall the predetermined text portion that is associated with the voice portion, means for associating the predetermined text portion

with information to be entered in the electronic device, and means for inserting the predetermined text portion into the information to be entered in the electronic device. as recited in claim 6, Applicants respectfully submit that *Groner does not* anticipate Applicants' independent claim 6.

Further, for at least the reason that *Groner* fails to disclose, teach, or suggest at least Applicants' computer readable medium having a program for entering predetermined text into an electronic device, the program comprising logic configured to perform the steps of entering a predetermined text portion into the electronic device, storing the predetermined text portion in a memory, recording a voice portion into the electronic device, storing the voice portion in the memory, associating the voice portion with the predetermined text portion, using voice recognition to recall the predetermined text portion that is associated with the voice portion, associating the predetermined text portion with information to be entered in the electronic device, and inserting the predetermined text portion into the information to be entered in the electronic device. as recited in claim 11, Applicants respectfully submit that *Groner does not* anticipate Applicants' independent claim 11.

Further, for at least the reason that *Groner* fails to disclose, teach, or suggest at least Applicants' system for entering predetermined text into an electronic device, comprising an input element for entering a predetermined text portion into the electronic device, a first memory for storing the predetermined text portion, a software code segment for recording a voice portion into the electronic device, a second memory for storing the voice portion, a software code segment for associating the voice portion with the predetermined text portion, a software code segment for associating the predetermined text portion with information to be entered in the electronic device, and voice recognition software to recall the predetermined text portion that is associated with the voice portion, where the input element inserts the predetermined text portion associated with the information to be entered into the electronic device. as recited in claim 16, Applicants respectfully submit that *Groner does not* anticipate Applicants' independent claim 16.

Claim 1

For convenience of analysis, independent claim 1, as amended, is repeated below in its entirety. Independent claim 1 is also representative of claims 6 and 11, which will not be repeated.

> 1. A method for entering ***predetermined*** text into an electronic device, the method comprising:
>
> entering a ***predetermined*** text portion into the electronic device;
>
> storing the ***predetermined*** text portion in a memory;
>
> recording a voice portion into the electronic device;
>
> storing the voice portion in the memory;
>
> associating the voice portion with the ***predetermined*** text portion;
>
> using voice recognition to recall the ***predetermined*** text portion that is associated with the voice portion;
>
> associating the ***predetermined*** text portion with information to be entered in the electronic device; and
>
> inserting the ***predetermined*** text portion into the information to be entered in the electronic device.

(Applicants' independent claim 1, as amended - *emphasis added.*)

Applicants respectfully assert that *Groner* fails to disclose, teach, or suggest at least the emphasized elements of pending claim 1 as shown above. Consequently, claim 1 is allowable.

Specifically, *Groner* fails to disclose, teach, or suggest at least Applicants' method for entering predetermined text into an electronic device comprising "using voice recognition to recall the ***predetermined*** text portion that is associated with the voice portion," "associating the ***predetermined*** text portion with information to be entered in the electronic device," and "inserting the ***predetermined*** text portion into the information to be entered in the electronic device."

Groner appears to disclose a voice to electronic mail system that converts voice message to text messages. Specifically, *Groner* states that

> [i]f the called party subscribes to the voice-to-electronic mail system 30, the voice-to-electronic mail system 30 receives a voice message from the caller, converts the voice message to a text message, and sends the text message, as an electronic mail (e-mail) message, to the recipient via the electronic mail system 40. The electronic mail system 40 sends the e-mail message over the packet-based network 42 for display on the recipient's text display device 44.

See Groner, col. 4, lines 37-44.

Groner, while describing the operation of the invention, continues stating

> [i]n step 52, the voice-to-electronic mail system 30 receives a spoken message from a caller for a recipient having a recipient telephone number. The voice-to-electronic mail system 30 receives the audio message when the caller speaks. In step 54, the voice-to-electronic mail system 30 determines an e-mail address for the recipient in accordance with the recipient's telephone number. In step 56, the voice-to-electronic mail system 30 stores the spoken message in an audio message file. In step 58, the voice-to-electronic mail system 30 generates a text message file from the audio message from the caller.

See Groner, col. 4, line 56 - col. 5, line 1.

From this, it is abundantly clear that *Groner* clearly describes a system in which an incoming voice message is converted into an electronic text file for delivery, via an electronic mail system, to a recipient. *Groner* continues stating that "[i]n step 60, the voice-to-electronic mail system 30 sends the text message file to the recipient at the recipient's e-mail address." *See Groner,* col. 5, lines 2-4. *Groner* continues stating that "[t]he voice-to-electronic mail system 30 automatically converts a spoken message to a text message which is e-mailed to a recipient. The computer system 70 generates a text message file from a caller's voice message." *See Groner*, col. 5, lines 7-10.

In marked contrast to *Groner*, the present invention discloses a method for entering predetermined text into an electronic device comprising at least "using voice recognition to recall the ***predetermined*** text portion that is associated with the voice portion," "associating the ***predetermined*** text portion with information to be entered in

the electronic device," and "inserting the ***predetermined*** text portion into the information to be entered in the electronic device."

Indeed, Applicants system and method define and associate a portion of predetermined text with a voice utterance, and use the voice utterance to recall the associated text. *Groner* merely appears to disclose a voice-to-electronic mail system that generates a text message from a voice recording, and emails the text recording to a subscribers email address.

Applicants respectfully disagree with the statement on page 3 of the Office Action that *Groner* discloses "means (84, 102) (Fig. 3) for associating the voice portion with the text portion." Applicants respectfully submit that the means referred to in the Office Action appears to be the disk controller 84, and the means 102 appears to be a voice/text switch procedure 102 that "determines whether a recipient is subscriber [sic] to the voice-to-electronic mail system 30 (FIG. 1)." *See Groner*, col. 5, lines 42-43. When describing the voice/text switch procedure 102 *Groner* continues stating that "if the recipient is not a subscriber, the voice/text switch procedure 102 switches the call to the voice mail system 38 (FIG. 1); if the recipient is a subscriber, the voice/text switch procedure 102 does not switch the call and the voice-to-electronic mail system 30 (FIG. 1) will further process the call." See *Groner*, col. 5, lines 44-50. Accordingly, Applicants respectfully disagree with the statement in the Office Action that *Groner* discloses means for associating the voice portion with the text portion. Applicants respectfully submit that the voice/text switch procedure 102 merely determines whether or not the recipient is a subscriber to the voice-to-electronic mail system 30, and switches the call accordingly. Applicants respectfully submit that nowhere does *Groner* disclose, teach or suggest Applicants' claimed feature of "associating the voice portion with the ***predetermined*** text portion."

Applicants also respectfully disagree with the statement on page 3 of the Office Action that *Groner* discloses "means (84, 116) (Fig. 3) for using voice recognition to recall the text portion that is associated with the voice portion (see col. 6, lines 6-9)." Applicants respectfully submit that the element 116 referred to in *Groner* is a "speech recognition procedure 116 that receives audio speech, identifies the audio speech and generates a text file 118 corresponding to the identified audio speech." *See Groner*,

col. 6, lines 6-9. Accordingly, Applicants respectfully submit that nowhere does the speech recognition procedure 116 described in *Groner* use voice recognition to "recall the ***predetermined*** text portion that is associated with the voice portion," as claimed in claim 1.

Further, Applicants respectfully disagree with the statement in the Office Action that *Groner* discloses "means (158) (Fig. 4) for associating the text portion with information to be entered in the electronic device (see col. 7, lines 13-17)." Applicants respectfully submit that the means 158 referred to in the Office Action is a step in Fig. 4 describing the dialog manager 104, whereby "the dialog manager 104 assembles the message header data structure 134 and text file 118 into an e-mail message 114, stores the e-mail message 140 in the e-mail message storage 138, and sends the e-mail message 140 to the recipient." See *Groner*, col. 7, lines 12-16. Accordingly, nowhere does *Groner*, in col. 7, lines 13-17, or elsewhere, disclose a means for associating the text portion with information to be entered into the electronic device.

Furthermore, Applicants respectfully disagree with the statement on page 4 of the Office Action that "Groner discloses that the method/system wherein voice recognition is used to identify the text portion (see col. 6 lines 6-9)." Applicants respectfully submit that, in col. 6, lines 6-9, *Groner* clearly discloses a speech recognition procedure 116 that receives audio speech, identifies the audio speech and generates a text file 118 corresponding to the identified audio speech. Applicants respectfully submit that nowhere does *Groner* disclose, teach or suggest that voice recognition is used to identify the text portion.

Thus, *Groner* fails to disclose, teach, or suggest each element of the Applicants' independent claims 1, 6 and 11. Consequently, Applicants respectfully submit that claims 1, 6 and 11 are allowable over *Groner* and request that the rejection of claims 1, 6 and 11 be withdrawn.

Because independent claims 1, 6 and 11 are allowable dependent claims 2-5, which depend directly from allowable independent claim 1, dependent claims 7-10, which depend directly from allowable independent claim 6, and dependent claims 12-15, which depend directly from allowable independent claim 11 are also allowable. *In re Fine,* 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection of claims 1-15 be withdrawn.

Claim 16

For convenience of analysis, independent claim 16, as amended, is repeated below in its entirety.

> 16. A system for entering ***predetermined*** text into an electronic device, comprising:
>
> an input element for entering a ***predetermined*** text portion into the electronic device;
>
> a first memory for storing the ***predetermined*** text portion;
>
> a software code segment for recording a voice portion into the electronic device;
>
> a second memory for storing the voice portion;
>
> a software code segment for associating the voice portion with the ***predetermined*** text portion;
>
> a software code segment for associating the ***predetermined*** text portion with information to be entered in the electronic device; and
>
> voice recognition software to recall the ***predetermined*** text portion that is associated with the voice portion, where the input element inserts the ***predetermined*** text portion associated with the information to be entered into the electronic device.

(Applicants' independent claim 16, as amended - *emphasis added.*)

Applicants respectfully assert that *Groner* fails to disclose, teach, or suggest at least the emphasized elements of pending claim 16 as shown above. Consequently, claim 16 is allowable.

Specifically, *Groner* fails to disclose, teach, or suggest at least Applicants' system for entering predetermined text into an electronic device, comprising "a software code segment for associating the ***predetermined*** text portion with information to be entered in the electronic device," and "voice recognition software to recall the ***predetermined*** text

portion that is associated with the voice portion, where the input element inserts the ***predetermined*** text portion associated with the information to be entered into the electronic device."

As mentioned above, *Groner* appears to disclose a voice to electronic mail system that converts voice message to text messages. Specifically, *Groner* states that

> [i]f the called party subscribes to the voice-to-electronic mail system 30, the voice-to-electronic mail system 30 receives a voice message from the caller, converts the voice message to a text message, and sends the text message, as an electronic mail (e-mail) message, to the recipient via the electronic mail system 40. The electronic mail system 40 sends the e-mail message over the packet-based network 42 for display on the recipient's text display device 44.

See Groner, col. 4, lines 37-44.

Groner, while describing the operation of the invention, continues stating

> [i]n step 52, the voice-to-electronic mail system 30 receives a spoken message from a caller for a recipient having a recipient telephone number. The voice-to-electronic mail system 30 receives the audio message when the caller speaks. In step 54, the voice-to-electronic mail system 30 determines an e-mail address for the recipient in accordance with the recipient's telephone number. In step 56, the voice-to-electronic mail system 30 stores the spoken message in an audio message file. In step 58, the voice-to-electronic mail system 30 generates a text message file from the audio message from the caller.

See Groner, col. 4, line 56 - col. 5, line 1.

From this, it is abundantly clear that *Groner* clearly describes a system in which an incoming voice message is converted into an electronic text file for delivery, via an electronic mail system, to a recipient. *Groner* continues stating that "[i]n step 60, the voice-to-electronic mail system 30 sends the text message file to the recipient at the recipient's e-mail address." *See Groner,* col. 5, lines 2-4. *Groner* continues stating that "[t]he voice-to-electronic mail system 30 automatically converts a spoken message to a text message which is e-mailed to a recipient. The computer system 70 generates a text message file from a caller's voice message." *See Groner*, col. 5, lines 7-10.

In marked contrast to *Groner*, the present invention discloses a system for entering predetermined text into an electronic device, comprising "a software code segment for associating the ***predetermined*** text portion with information to be entered in the electronic device," and "voice recognition software to recall the ***predetermined*** text portion that is associated with the voice portion, where the input element inserts the ***predetermined*** text portion associated with the information to be entered into the electronic device."

Indeed, Applicants system is used to define and associate a portion of predetermined text with a voice utterance, and use the voice utterance to recall the associated text. *Groner* merely appears to disclose a voice-to-electronic mail system that generates a text message from a voice recording, and emails the text recording to a subscribers email address.

Applicants respectfully disagree with the statement on page 5 on the Office Action that *Groner* discloses "a software code segment (104) for associating the text portion with information to be entered in the electronic device (see col. 5, lines 51-62 and col. 7, lines 13-17)." Applicants respectfully submit that the software code segment 104 referred to in the Office Action is the dialog manager 104, whereby "the dialog manager 104 assembles the message header data structure 134 and text file 118 into an e-mail message 114, stores the e-mail message 140 in the e-mail message storage 138, and sends the e-mail message 140 to the recipient." *See Groner*, col. 7, lines 12-16. Further, *Groner* states that the dialog manager:

> conducts an interchange of prompts and responses with the caller to process the call; in addition, the dialog manager 104 stores audible signals, including spoken words, in a digitized audio format in a voice message 110 in the voice message storage 112; the dialog manager 104 is a software module having instructions for performing at least a subset of the steps shown in FIGS. 2, 4, 5, and 11A-11E.

Groner, col. 5, lines 53-62. Accordingly, nowhere does *Groner*, in col. 5, lines 51-62, in col. 7, lines 13-17, or elsewhere, disclose a software code segment for associating the ***predetermined*** text portion with information to be entered in the electronic device.

Applicants also respectfully disagree with the statement on page 5 of the Office Action that *Groner* discloses "voice recognition software (104) to recall the text portion that is associated with the voice portion, where the input element insert the text portion

associated with the information to be entered into the electronic device (see col. 5, lines 51-62 and col. 7, lines 13-17)." Applicants respectfully submit that the voice recognition software 104 referred to in the Office Action is the dialog manager 104, whereby "the dialog manager 104 assembles the message header data structure 134 and text file 118 into an e-mail message 114, stores the e-mail message 140 in the e-mail message storage 138, and sends the e-mail message 140 to the recipient." *See Groner*, col. 7, lines 12-16. Further, *Groner* states that the dialog manager:

> conducts an interchange of prompts and responses with the caller to process the call; in addition, the dialog manager 104 stores audible signals, including spoken words, in a digitized audio format in a voice message 110 in the voice message storage 112; the dialog manager 104 is a software module having instructions for performing at least a subset of the steps shown in FIGS. 2, 4, 5, and 11A-11E.

Groner, col. 5, lines 53-62. Accordingly, nowhere does *Groner*, in col. 5, lines 51-62, in col. 7, lines 13-17, or elsewhere, disclose voice recognition software to recall the ***predetermined*** text portion that is associated with the voice portion, where the input element inserts the ***predetermined*** text portion associated with the information to be entered into the electronic device.

Furthermore, Applicants respectfully disagree with the statement on page 6 of the Office Action that "Groner discloses that the system wherein voice recognition is used to identify the text portion (see col. 6 lines 6-9)." Applicants respectfully submit that, in col. 6, lines 6-9, *Groner* clearly discloses a speech recognition procedure 116 that receives audio speech, identifies the audio speech and generates a text file 118 corresponding to the identified audio speech. Applicants respectfully submit that nowhere does *Groner* disclose, teach or suggest that voice recognition is used to identify the text portion.

Thus, *Groner* fails to disclose, teach, or suggest each element of the Applicants' independent claim 16. Consequently, Applicants respectfully submit that claim 16 is allowable over *Groner* and request that the rejection of claim 16 be withdrawn.

Because independent claim 16 is allowable, dependent claims 17-20, which depend directly from allowable independent claim 16 are also allowable. *In re Fine,* 837

F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection of claims 16-20 be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants respectfully request that all outstanding rejections be withdrawn and that all pending claims of this application be allowed to issue. If the Examiner has any comments regarding Applicants' response or intends to dispose of this matter in a manner other than a notice of allowance, Applicants request that the Examiner telephone Applicants' undersigned attorney.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

CUSTOMER NO. 23859

By: 

Michael J. Tempel
Registration No. 41,344
(678) 420-9300